

**REMARKS**

Claims 126-128, 131, 144, 149, 150, 157, and 159-172 were pending in the application. Claim 167 has been amended. Accordingly, upon entry of the amendments presented herein, claims 126-128, 131, 144, 149, 150, 157, and 159-172 will remain pending in the application.

Support for the amendment to claim 167 may be found throughout the specification and claims as originally filed. Specifically, support for claim 167 may be found, for example, at page 6, lines 15-18 and in Figure 1A.

No new matter has been added. Any amendments to and/or cancellation of the claims was done solely to more particularly point out and distinctly claim the subject matter of Applicants' invention in order to expedite the prosecution of the application. Applicants reserve the right to pursue the claims as originally filed in this or a separate application(s).

## **RESPONSE TO RESTRICTION REQUIREMENT**

### **Election With Traverse**

The Examiner has indicated that Applicants are required, under 35 U.S.C. § 121, to elect a single disclosed species to which the claims shall be restricted if no generic claim is finally held to be allowable. Specifically, the Examiner has requested election of one of the following polypeptide species (claims 165, 166, and 168-172):

- (a) SEQ ID NO:36 and SEQ ID NO:43;
- (b) SEQ ID NO:7;
- (c) SEQ ID NO:3;
- (d) SEQ ID NO:4
- (e) SEQ ID NO:5
- (f) SEQ ID NO:6 and
- (g) SEQ ID NO:8.

Applicants have amended claim 167, previously directed to the method of claim 126, wherein the isolated polypeptide comprises SEQ ID NO:2, to be directed to the method of claim 126, wherein the isolated polypeptide comprises SEQ ID NO:1. **Accordingly, Applicants hereby provisionally elect, *with traverse*, the species of SEQ ID NO:1 (claim 167).**

The present Restriction Requirement is the second restriction requirement that has issued in this case. In response to the first restriction requirement that issued on April 23, 2003, Applicants elected, with traverse, Group I, namely claims 126-131 and 144, directed to a method for resuscitating bacterial cells by contacting the cells with an isolated polypeptide having at least 20% to 50% identity with residues 117-184 of SEQ ID NO:2. Accordingly, in the present Restriction Requirement, Applicants are assuming that the Examiner did not include SEQ ID NO:2 in the list of polypeptide species for election because the Examiner already searched SEQ ID NO:2 as a result of the previous election. Therefore, it is Applicants' understanding that the elected species of SEQ ID NO:1 will be examined *in addition to* the species of SEQ ID NO:2. Applicants respectfully request that the Examiner confirm that Applicants' understanding is accurate. Further, Applicants note that

the election of species is for search and examination purposes. It is Applicants' understanding that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent from or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141 *et seq.*

### **Grounds for Traversal**

Applicants respectfully submit that the present Restriction Requirement is improper, and respectfully traverse the same on the following grounds. Each of these grounds provides an independently sufficient basis for concluding that the Restriction Requirement is improper.

First, the Examiner has incorrectly alleged that the polypeptide species above do not share significant common structure. In contrast to the Examiner's assertions, **the species do, in fact, share significant common structure**, as required by the genus claims. Specifically, genus claim 126, upon which species claims 165-172 are dependent, requires that the polypeptide species have "at least 50% sequence identity with amino acid residues 117 to 184 of SEQ ID NO:2." The Manual of Patent Examining Procedure (MPEP) explains that

[w]here there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction. See MPEP section 808.01(a) at page 800-52, right column, first full paragraph.

Applicants respectfully submit that in the present Restriction Requirement, the Examiner has not discussed the disclosed relationship between the claimed polypeptide species, much less has the Examiner advanced reasons leading to the conclusion that the disclosed relation does not prevent restriction. Thus, Applicants submit that the present Restriction Requirement is improper on this basis alone.

Second, the requirement for an election among only eight polypeptide species is improper because the MPEP states that "**normally ten sequences constitute a reasonable number for examination purposes.**" MPEP section 803.04 at page 800-10, left column, third paragraph. Section 803.04, although titled "Nucleotide Sequences," also refers to protein amino acid

sequences<sup>1</sup>, thereby indicating that this section also applies to polypeptide sequences. Therefore, in accordance with MPEP section 803.04, it is reasonable that the Examiner search and examine up to ten polypeptide sequences. **Because the Examiner has requested an election among only seven species in the present case, Applicants submit that the present Restriction Requirement is improper.**

This second ground is an independently sufficient reason that the present Restriction Requirement is improper. It is independent from the first ground, because the first ground relies on the relatedness of the sequences of the polypeptide species, whereas the second ground does not. The rule that ten sequences constitute a reasonable number for examination purposes would apply even if the sequences were *not* structurally related, because the cited portion of MPEP section 803.04 continues by stating that, “[a]ccordingly, in most cases up to ten *independent and distinct* nucleotide sequences will be examined in a single application without restriction.” MPEP section 803.04 at page 800-10, left column, third paragraph. The fact that the sequences of the species in the present case show structural similarity reduces the examination burden compared with a situation where the sequences are independent and distinct. Clearly, the examination of *only nine, related* polypeptide sequences (*i.e.*, (a) SEQ ID NO:2, (b) SEQ ID NO:36 and SEQ ID NO:43, (c) SEQ ID NO:7, (d) SEQ ID NO:3, (e) SEQ ID NO:4, (f) SEQ ID NO:5, (g) SEQ ID NO:6, (h) SEQ ID NO:8, and (i) SEQ ID NO:1) places a lesser burden on the Examiner than contemplated by MPEP section 803.04, which indicates that it is reasonable that the Examiner search and examine ten unrelated polypeptide sequences.

Third, the official file history of the USPTO indicates that **the claimed genus has already been searched**. Specifically, the "Examiner's search strategy and results" posted on PAIR with a mail room date of June 9, 2008 and attached herewith as Appendix A indicates that the Examiner already searched polypeptides having at least 50% identity with amino acid residues 117-184 of SEQ ID NO:2. Thus, there is no search burden on the Examiner that warrants further restriction.

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<sup>1</sup> For example, in the last paragraph of the left column at page 800-10, the MPEP states “In some exceptional cases, the complex nature of the claimed material, for example a *protein amino acid sequence* reciting three dimensional folds, may necessitate that the reasonable number of sequence to be selected be less than ten.”

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the present Restriction Requirement.

**SUMMARY**

In view of the foregoing remarks, reconsideration of the rejections and allowance of all pending claims is respectfully requested. If there are any remaining issues or if the Examiner believes that a telephone conversation with Applicants' Attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at (617) 449-6512.

The Commissioner is hereby authorized to charge any fees associated with the filing of this communication to our Deposit Account No. 50-4876, under Order No. **118160-00301** from which the undersigned is authorized to draw.

Dated: November 8, 2011

Respectfully submitted,

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